



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/663,697	09/17/2003	Hitoshi Nagata	031156	3967

23850 7590 01/12/2006

ARMSTRONG, KRATZ, QUINTOS, HANSON & BROOKS, LLP  
1725 K STREET, NW  
SUITE 1000  
WASHINGTON, DC 20006

EXAMINER

CAO, ALLEN T

ART UNIT	PAPER NUMBER
----------	--------------

2652

DATE MAILED: 01/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/663,697

Applicant(s)

NAGATA ET AL.

Examiner

Allen T. Cao

Art Unit

2652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Art Unit: 2652

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of copending Application No. 10/663,696. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

a) Claims 1-2 and 4 of the present invention application are substantially same as the combination limitations of claims 1-3 and 12-13 of the copending application 10/663,696. All the major limitations of the claims 1-2 and 4 of the present invention application have been disclosed by the copending application 10/663,696 except some minor used languages.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to rearrange the combination limitations of claims 1-3 and 12 of the copending application in order to match with the limitations of claims 1-2 and 4 as set forth in present invention application.

b) Claim 3 of the present invention application is substantially same as claim 2 of the copending application 10/663,696.

c) Claim 4 of the present invention application is same as claim 13 of the copending application 10/663,696.

d) Claim 5 of the present invention application is substantially same as claim 1 of the copending application 10/663,696.

e) Claim 6 of the present invention application is substantially same as claim 4 of the copending application 10/663,696.

f) Claim 7 of the present invention application is same as claim 5 of the copending application 10/663,696.

g) Claim 8 of the present invention application is same as claim 6 of the copending application 10/663,696.

h) Claim 9 of the present invention application is same as claim 7 of the copending application 10/663,696.

i) Claim 10 of the present invention application is same as claim 9 of the copending application 10/663,696.

j) Claim 11 of the present invention application is same as claim 10 of the copending application 10/663,696.

k) Claim 12 of the present invention application is same as claim 11 of the copending application 10/663,696.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

3. Claim 2 is objected to because of the following informalities: the term "a" in front of the phrase "bare disk" in claim 2, line 7 should be changed to --said--. Appropriate correction is required.

4. Claim 2 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 2 is substantially same as claim 1 except the phrase "one of the cartridge and a bare disk"; however, the term "one of ... and" considered an alternative choice.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Kawamura et al (US. 5,812,511).

Kawamura et al discloses a reproducing/recording apparatus comprising a first reproducing/recording mechanism (the head, for example: the head 13) for reproducing data from and/or recording data onto a cartridge/disk combination 62, a disk main body being contained in the cartridge (figure 2); the first reproducing/recording mechanism having a traversing mechanism disposed oppositely relative to the recording area of

Art Unit: 2652

said cartridge/disk combination (figures 9A-9C, 14A-15C, 26A-26C show a traversing mechanism) and a clamping mechanism 8 disposed oppositely relative to the traversing mechanism with the cartridge/disk combination interposed between them, the clamping mechanism having a keep member (balls 35) adapted to urge (push) said cartridge/disk combination toward the side of the traversing mechanism at the time of clamping said cartridge/disk combination (column 9, lines 15-38), all as set forth in claims 1 and 2.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kawamura et al in view of Inoue et al (US. 6,665,255 B1).

Kawamura et al also discloses that the first reproducing/recording mechanism is arranged at the side of the disk inlet/outlet and the bare disk is arranged remotely from the disk inlet/outlet port with the reproducing/recording mechanism interposed between them.

Kawamura et al, however, does not disclose a second reproducing/recording mechanism for reproducing data from and/or recording data onto a bare disk.

Inoue et al discloses a loading/unloading mechanism having a first reproducing/recording mechanism 3 for read/write data from a disk cartridge CDS (column 8, line 62 to column 9, line 17; see also claim 1); and a second

reproducing/recording mechanism 4 for read/write data from a bare disk DS (column 7, line 59 to column 8, line 2; see also claim 1).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the loading/unloading apparatus of Kawamura et al with an additional second read/write mechanism as set forth, supra as taught by Inoue et al.

The rationale is as follows: One of ordinary skill in the art would have been motivated to provide the loading/unloading apparatus of Kawamura et al with an additional second read/write mechanism as set forth, supra as taught by Inoue et al to speed up the write/read characteristics of the disk cartridge and the bare disk in order to improve the read/write characteristics of the disk apparatus. Additionally, it also provide a more variety choices of loading/unloading different media.

9. Claims 4-12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. Applicant's arguments filed 10/12/05 have been fully considered but they are not persuasive.

In the REMARKS, Applicant argues that the provisional double patenting rejection is not proper (see Applicant's REMARKS, pages 8-9).

Claims 1-3 of the Application 10/663,696 disclose substantially all the limitations of the claim 1, lines 1-4 of the present Application except some minor used languages.

Claims 12 and 13 of the Application 10/663,696 disclose substantially all the limitations of the claim 1, lines 5-10 of the present Application except some minor used languages.

Claims 2-3 and 12-13 (of the Application 10/663,696) are depending to claim 1 (of the Application 10/663,696).

Therefore, the Examiner maintains that the provisional double patenting is proper as set forth, in the above Office Action.

Applicant also argues that Kawamura is not a proper basis for rejection because Kawamura does not disclose a "keep member"... that urges (a corner of) the cartridge of the cartridge-disk.

The Examiner respectfully points out that Applicant argues the limitations which are not in the claim. Applicant does not claim for urging **(a corner of)** the cartridge of the cartridge disk. Applicant only claims for "a keep member **adapted** to urge said cartridge toward the side of the traversing ...".

Kawamura has been relied for disclosing the clamping mechanism having a keep member (balls 35) adapted to urge (push) said cartridge/disk combination toward the side of the traversing mechanism at the time of clamping said cartridge/disk combination (column 9, lines 15-38).

Therefore, The Examiner again maintains the rejection is proper.

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).



A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Allen T. Cao whose telephone number is (571) 272-7569. The examiner can normally be reached on Mon - Thurs (7:30 - 6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea Wellington can be reached on (571) 272-4483. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2652

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Allen Cao', with a long horizontal flourish extending to the right.

Allen Cao  
Primary Examiner

AC  
January 05, 2006